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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,635	08/05/2003	Thomas D. Reyes	014208.1626 (70-03-005)	7200
35005 7590 01/29/2008 BAKER BOTTS L.L.P. 2001 ROSS AVENUE, 6TH FLOOR DALLAS, TX 75201-2980			EXAMINER OYEBISI, OJO O	
			ART UNIT 3694	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail2@bakerbotts.com
PTOmail4@bakerbotts.com

Office Action Summary

Application No.

10/634,635

Applicant(s)

REYES, THOMAS D.

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buttridge et al (Buttridge hereinafter, Pub No.: US 2004/0044606) IN VIEW OF Robinson et al (Robinson hereinafter, US PAT: 6978046).

Re claims 1, 2-8. Buttridge further discloses a computerized method for effecting payment by a check, comprising: electronically receiving payment information for a check drawing on a checking account of an account holder, the payment information comprising a date, a payee, a dollar amount, a legal amount, and a signature in response to receiving the payment information (see col.2 paras 0012-0017). Buttridge does not explicitly disclose, retrieving, from a storage location, an image replacement document template associated with the checking account; and generating an image

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replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template. However, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claim 9, 10-16. Buttridge further discloses Logic encoded in media for effecting payment by a check, the logic operable to perform the following steps: receive payment information for a check drawing on a checking account of an account holder, the payment information comprising a date, a payee, a dollar amount, a legal amount, and a

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signature (see col.2 paras 0012-0017). Buttridge does not explicitly disclose retrieve, from a storage location, an image replacement document template associated with the checking account in response to receiving the payment information; and generate an image replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template.

However, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check).

Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

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Re claims 17, 18-21. Buttridge further discloses a computerized method for effecting payment by a check, comprising: generating, on an output device, an electronic image of a check drawing on a checking account of an account holder; receiving payment information for the check on the output device (see col.3 paras 0031, also see fig.1 element 22). Buttridge does not explicitly disclose generating a snippet of the payment information; and electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet. However, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing

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document that are visually coherent with the predetermined visual design of the document.

.Re claims 22, 23-28. Buttridge further discloses Logic encoded in media for effecting payment by a check, the logic operable to perform the following steps: generate an electronic image of a check drawing on a checking account of an account holder on an output device; receive payment information for the check on the output device (see col.3 paras 0031, also see fig.1 element 22). Buttridge does not explicitly disclose generate a snippet of the payment information; and electronically transmit the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet. However, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and

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human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Re claims 29, 30-35. Buttridge further discloses a computerized method for effecting payment by a check, comprising: generating, on an output device, an electronic image of a check drawing on a checking account of an account holder; receiving payment information for the check on the output device, the payment information comprising a date, a payee, a dollar amount, a legal amount, and a signature (see col.3 paras 0031, also see fig.1 element 22). Buttridge does not explicitly disclose generating a snippet of the payment information; electronically transmitting the snippet to a remote location; electronically receiving the snippet at the remote location; in response to receiving the snippet, retrieving, from a storage location, an image replacement document template associated with the checking account; and generating an image replacement document representative of the check by inserting the payment information from the snippet into respective fields of the image replacement document template. However, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e., According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document, see fig.2 element s1700, see

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col.2 lines 50-62, also see the abstract and the summary of the invention, the examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Response to arguments

Applicant's arguments filed 10/30/07 have been fully considered but they are not persuasive. The applicant argues in substance that the combination of *Buttridge and Robinson* fails to disclose/teach the following limitations recited in Claim 1:

- in response to receiving the payment information, retrieving, from a storage location, an image replacement document template associated with the checking account; and generating an image replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template.

Contrary to the applicant's assertion, the secondary reference, Robinson explicitly discloses an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template (i.e.,

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The systems and methods according to this invention allow the scan/preparation user generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design theme of the document, see col.2 lines 50-62, also see "Once the attributes of the objects are identified, a template containing the attributes is synthesized. Once created, the template is saved in any desired template format for use with word processing software or the like. The template can then be used to create additional/replacement pages for the existing document that are visually coherent with the predetermined visual design theme of the document, " Robinson, col.3 lines 7-14). The examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check.

The applicant further argues in substance that the examiner fails to establish a *prima facie* case of obviousness based on the proposed Buttridge-Robinson combination with respect to claim 1. The examiner contends that the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art, rather than by their specific disclosures (In re McLaughlin, 170 USPQ 209 (CCPA 1971); In re Bozek, 163 USPQ 545 (CCPA) 1969). In this particular case, the examiner expressly provides motivation for the combination of Buttridge-Robinson references. That is to say, with respect to claim 1, one of ordinary skill in the art would have been motivated to combine the teachings of Buttridge and Robinson so that manual labor and human

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errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES TRAMMELL can be reached on (571)272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


ELLA COLBERT
PRIMARY EXAMINER